

U.S. Patent Application Serial No. 10/535,422
Amendment filed July 16, 2009
Reply to OA dated March 24, 2009

REMARKS

Claims 1-8, 11-16, 18 and 20 are pending in this application. Claims 8, 15 and 20 are canceled without prejudice or disclaimer, claims 1 and 3 are amended herein. Upon entry of this amendment, claims 1-7, 11-14, 16 and 18 will be pending. Entry of this amendment and reconsideration of the rejections are respectfully requested.

No new matter has been introduced by this Amendment. Support for the amendment to claim 1 is discussed below. The amendment to claim 3 corrects a minor typographical error.

Claims 1-8, 11-16 and 18 are rejected under 35 U.S.C. §103(a) as being unpatentable over Berns (U.S. Patent No. 5,503,687) in view of Wikipedia (http://en.wikipedia.org/wiki/Ferritic_stainless_steel) and further in view of Gordon (U.S. Pub. No. 2002/0133225 A1). (Office action paragraph no. 3)

On page 4 of the Office action, the Examiner states that Berns in view of Wikipedia does not specify the claimed stent that is expandible in outside diameter. The Examiner cites Gordon at paragraph [0057] as disclosing a ferritic stainless steel stent. The Examiner states that it would have been obvious to use the nitrogen-treated ferritic stainless steel of Berns in view of Wikipedia for the stent of Gordon, because the structures in Berns and Gordon are similar.

Reconsideration of the rejection is respectfully requested in view of the amendment to claim 1. Claim 1 has been amended in the last clause as follows: "... to transform all of said ferritic

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stainless steel tube to austenite." Support for the amendment to claim 1 may be found in original claim 9 of the application.

In responding to the rejection, Applicant first of all again strongly argues that the Wikipedia reference is not a proper reference, since it represents an Internet webpage whose contents are subject to change, and there is no documentation that the present contents were available before the US filing date of the present application. MPEP 2128 discusses "electronic publications" and states that: "If the publication does not include a publication date it cannot be relied on as prior art under 35 U.S.C. 102(a) or (b), although it may be relied upon to provide evidence regarding the state of the art." This argument was made previously by Applicant in the Response filed December 8, 2008, and the Examiner apparently did not respond to this argument in the Office action of March 24, 2009.

The Office action cites Berns as disclosing a method for producing a component comprising bringing a ferritic stainless steel component in contact with a gas containing nitrogen at a temperature to make the component absorb nitrogen to transform at least part of the ferritic stainless steel to austenite.

"As a result of the amendment to claim 1, the nitrogen absorption step of claim 1 now reads: a nitrogen absorption step of bringing said stent into contact with a gas containing nitrogen at a predetermined treatment temperature or more to make said ferritic stainless steel forming said stent absorb nitrogen to transform **all of said ferritic stainless steel** to austenite." (emphasis added)

In contrast to claim 1, Berns states that: "**martensitic of ferritic structure portions in the surface zone** are converted to austenite" (column 1, line 36, emphasis added). Furthermore, Berns

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also states that: [the] “austenitic surface layer is formed over a core structure of ferrite” (column 1, line 54). That is, Berns only discloses that portions in the surface zone are converted to austenite.

Applicant notes that the Office Action cites Wikipedia only to indicate that the limitation of “substantially free of Ni” in the present claims is met by ferritic stainless steel.

Therefore, Berns, even in combination with Wikipedia, fails to teach, suggest or motivate the limitation “to transform **all of the ferritic stainless steel tube** to austenite,” which is recited in claim 1 of the present application.

Moreover, the Office action admits that Berns in combination of Wikipedia fails to specify the “stent extendible in outside diameter.” In connection with this, the Office Action cites the Gordon (US 2002/0133225), which discloses a ferritic stainless steel stent containing slots and holes ([0057]), and asserts that applying the nitrogen treated ferritic stainless steel of Berns in view of Wikipedia to the stent disclosed by Gordon would have achieved the present invention.

However, the general disclosure of Gordon is of a method and apparatus for delivering a medical agent to a medical implant where the medical implant includes magnetized material, such as ferromagnetic material ([0024]-[0025]). The stent disclosed in paragraph [0057] of Berns, cited by the Examiner, is then used to bind superparamagnetic iron oxide nanoparticles ([0058]). The ferromagnetic material may comprise a superelastic ferromagnetic material that is selected from the group comprising the alloy of: Ni₂MnGa, FePd or FeNiCoTi (claim 5 of Gordon). That is, the material disclosed in Gordon may include Ni. Therefore, there is no motivation in Gordon for the “substantially free of Ni” limitation of claim 1.

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Moreover, the ferritic stainless steel of Gordon is only cited as one example of a ferromagnetic material, but the reason for using ferromagnetic material in Berns is **for the magnetic property**, which is used to bind delivered agents. Therefore, the basis for material selection in Gordon is completely different from that in Berns. The disclosure of Berns would be irrelevant for the non-stainless steel materials in Gordon. Hence, there is no reasonable motivation to combine the invention of Gordon with the invention of Berns.

As discussed above, Berns in view of Wikipedia fails to teach, suggest, or disclose at least the limitation of “all of the ferritic stainless steel tube to austenite,” which is recited in the present claim 1. Also, there is no motivation to combine Gordon with Berns in view of Wikipedia, as the inventions therefore are fundamentally different. Thus, the present invention is not obvious over Berns, Wikipedia, and Gordon, taken individually or in combination.

Claim 20 is rejected under 35 U.S.C. §103(a) as being unpatentable over Berns ('687) in view of Wikipedia and further in view of Gordon ('225 A1) as applied to claim 1 above and further in view of Trozera (U.S. Patent No. 6,545,748). (Office action paragraph no. 4)

The rejection is moot in view of the cancellation of claim 20 without prejudice or disclaimer.

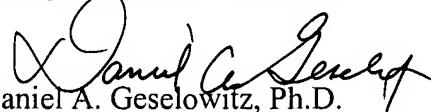
If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact the applicants' undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

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In the event that this paper is not timely filed, the applicants respectfully petition for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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Enclosure: Petition for Extension of Time

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